

Appl. No.: 10/029,159
Amdt. dated 05/06/2005
Reply to Office action of December 6, 2004

REMARKS

Claims 21-27 and 33-42 were pending at the time of the issuance of the Official Action. Claims 21, 22, 36 and 39 were rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. Although Applicants disagree with the substance of the rejection as described below, each of these claims has been amended to be more clearly within the technological arts by reciting that various ones of the steps set forth by Claims 21, 22, 36 and 39 are performed at or with a network based device, a wireless mobile device and/or a user device. Claims 21-27 and 33-42 were also rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. US 2002/0010698 to Dong Wook Shin, et al. Independent Claims 21, 22, 35, 36, 39 and 42 have each been amended to further patentably distinguish the claimed invention from the Shin '698 publication. Additionally, dependent Claim 41 has been amended to correct the punctuation. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration of the present application and allowance of the amended set of claims.

Claims 21, 22, 36 and 39 Define Statutory Subject Matter

The Official Action alleges that Claims 21, 22, 36 and 39 are directed to non-statutory subject matter. Specifically, the Official Action alleges that these claims do not apply, involve, use, or advance the technological arts. The Official Action essentially argues that the steps of these claims can be performed in person or by use of pencil and paper and that no specific technology is expressly recited in the body of the claims. Applicants respectfully submit, however, that the Official Action's reasons for rejections are not in line with current U.S. patent laws as defined by the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998).

In *State Street*, the Federal Circuit stated that, for the most part, any invention that is one of a process, machine, manufacture, or composition of matter is statutory subject matter. The court, however, noted three exceptions to this rule, namely laws of nature, natural phenomena, and abstract ideas. The court touched on the latter exception of abstract ideas. *State Street*, 149

F.3d at 1373. In this regard, the court stated that the test is that the invention must 1) fall into one of the listed categories: process, machine, manufacture, or composition of matter, and 2) produce a “useful, concrete, and tangible result.” In this regard, the claims at issue are directed to methods for providing, delivering or using selected content. The terms method and process are considered synonymous in patent law and, as such, meets the first requirement of *State Street*.

Furthermore, Claims 21, 22, 36 and 34 produce a useful, concrete, and tangible result, as the invention is useful for providing selected content in such a manner that operation of the selected content is pursuant to a selected requirement. In the same manner that the determination of share prices was adjudged by the Federal Circuit in *State Street* to be a concrete, tangible, and useful result, the selected content and associated locking requirement that are provided by the method of the claimed invention are a concrete, tangible, and useful result and are evidence of the practical application of the claimed invention. Therefore, the second requirement of *State Street* is also satisfied. This is all that is needed to qualify as statutory subject matter as outlined by the Federal Circuit. *See State Street*, 149 F.3d, at 1375.

Applicant notes here that the court nowhere mentions determining whether the claims “apply, involve, use, or advance the technological arts” as the Official Action is requiring. In fact, this phrase is no where present in the court’s opinion.

Applicant submits that the *State Street* opinion provides a good example of why the present invention should be considered statutory subject matter. Specifically, in that case, the Federal Circuit found that a system that determined a daily allocation of assets for two or more Spokes that are invested in the same Hub was statutory subject matter. The system determined the percentage share that each Spoke maintained in the Hub, while taking into consideration daily changes both in the value of the Hub's investment securities and in the concomitant amount of each Spoke's assets. The functions performed by the machine in *State Street* could have clearly been done with pen and paper. However, the Federal Circuit found the system to contain statutory subject matter. As such, the Office Action’s finding that the present invention is not statutory subject matter because the steps listed can be performed with pen and paper is

completely contrary to the findings of the Federal Circuit in an analogous holding in the *State Street* case.

As noted above, Applicants respectfully disagree with this rejection, but in order to expedite prosecution, have amended independent Claims 21 and 36 to recite both a network based device and a user device in the body of the claim, Claim 22 to recite a wireless mobile device in the body of the claim, and Claim 39 to recite the user device in the body of the claim. In light of the amendments to independent Claims 21, 22, 36 and 39 and the foregoing remarks, Applicants submit that Claims 21, 22, 36 and 39 recite statutory subject matter. The rejection under 35 U.S.C. §101 of Claims 21, 22, 36 and 39 has therefore been overcome.

The Claims are Patentable

In general terms, embodiments of the present invention are directed to locking selected content in a user device, such as a wireless mobile device, such that the selected content is repeatedly presented until a locking requirement is met. The selected content may take various forms, including a ring tune or a screen saver that is presented by being played or displayed, respectively, until the locking requirement is met. The locking requirement can also take various forms, such as a predefined number of days or a predefined amount of usage, such as a predefined number of instances in which a ring tune is played or a screen saver is displayed.

In one example, a network based device can present the user of a wireless mobile device with the opportunity to lock in some selected content in exchange for a reward, such as a discounted movie ticket. In some instances, the user is presented with several different locking requirements associated with the same selected content with those locking requirements that require the selected content to be locked in for longer periods of time or to be used more times also being associated with greater rewards, such as a more deeply discounted movie ticket. The user can then select one of the locking requirements, and the selected content and associated locking requirement are then downloaded from the network based device and stored by the user device. Thereafter, the selected content is provided to the user in accordance with the locking requirement. In this regard, the selected content may be repeatedly presented by the user device until the selected locking requirement is met. For example, a user may lock a ring tune that is a

snippet of a new movie's theme song, for two weeks in exchange for 50% off of a ticket to that same movie. Thus, the selected ring tune would be played in response to every incoming call during the next two weeks.

Independent Claim 21 is directed to a method for providing selected content from a network based device to a user device. The method of independent Claim 21 receives an indication of the selected content, presents at least one locking requirement associated with the selected content to the user device, receives a selection of at least a first locking requirement at the network based device in response to the presentation of at least one locking requirement, and thereafter provides the selected content from the network based device to the user device together with the at least first locking requirement following selection of the content and at least the first locking requirement, thereby permitting the selected content to be operated upon pursuant the first selected locking requirement. Similarly, independent Claim 22 is directed to a method for providing selected content to a user at a wireless mobile device that includes the steps of transmitting an indication of the selected content, receiving at least one locking requirement associated with a selected content at the wireless mobile device, selecting acceptance of at least a first locking requirement at the wireless mobile device, receiving the selected content and storing the selected content at the wireless mobile device following the selection of the content and at least the first locking requirement and thereafter operating upon the selected content in accordance with the first locking requirement.

In contrast, the Shin '698 publication employs a locking function to secure electronic documents pending satisfaction of predefined reading conditions. In this regard, an electronic document may be locked prior to being downloaded or otherwise transmitted to a user device. If locked, an electronic document is associated with a locking condition that specifies under which conditions the electronic document may be unlocked. Exemplary conditions include a date on which the electronic document can be opened, a particular reader who can open the electronic document or questions that a potential reader must answer correctly in order to access the locked electronic document. See Paragraph 23. Once locked, the electronic document is transmitted or downloaded from a source to a destination device. The destination device must then satisfy the

locking condition in order to access the electronic document, as failure to satisfy the locking condition will prevent the electronic document from being accessed.

In contrast to the Shin '698 publication, independent Claim 21 recites that at least one locking requirement is presented to the user device, and a selection of at least the first locking requirement is received at the network based device from the user device such that the selected content and at least the first locking requirement that has been selected are thereafter provided by the network based device to the user device. Thus, the user device to which the network based device eventually downloads the selected content and the selected locking requirement is also the user device at which at least one locking requirement is initially presented and at which a selection of at least the first locking requirement is received. With reference to the Shin '698 publication by contrast, the source of an electronic document (not the recipient) selects a locking condition to be associated with the electronic document prior to downloading or transmitting the electronic document to a recipient. In fact, since the association of a locking requirement with the electronic document has been done by the source, the recipient in the system of the Shin '698 publication is not presented with at least one locking requirement and does not permit receipt of a selection of a first locking requirement from among those presented, as set forth by independent Claim 21. Instead, the recipient receives the electronic document after the electronic document has already been locked without any input from the recipient.

Likewise, independent Claim 22 recites receiving at least one locking requirement at the wireless mobile device, selecting acceptance of at least a first locking requirement at the wireless mobile device, and then receiving the selected content and storing the selected content at the wireless mobile device following selection of the content and the first locking requirement. As described above, the Shin '698 publication does not teach or suggest the display of at least one locking requirement and the subsequent acceptance of a first one of the displayed locking requirements by the wireless mobile device to which the selected content is thereafter downloaded and stored. In direct contrast, the locking condition is applied to an electronic document by the source prior to transmission to a recipient in accordance with the Shin '698 publication.

For each of the foregoing reasons, independent Claims 21 and 22, as well as the claims that depend therefrom, are not taught or suggested by the Shin '698 publication.

Independent Claim 35 recites a mobile device including a content manager capable of selectably locking the selected content pursuant to a first selected locking requirement such that the selected content is repeatedly presented until the first selected locking requirement is met, determining when the first selected locking requirement is met, and unlocking the selected content when the first selected locking requirement is determined to have been met such that the selected content is no longer required to be repeatedly presented. As described by independent Claim 35, the selected content is therefore repeatedly presented until the first selected locking requirement is met, at which time the selected content need no longer be repeated. In direct contrast, the Shin '698 publication describes a method of locking an electronic document that prohibits the electronic document from being opened and operated until after the locking condition is met. Thus, independent Claim 35 recites the repeated presentation of the selected content until the first selected locking requirement is met, while the Shin '698 publication describes the prevention of the opening or other operation of the electronic document until the locking condition is met. Additionally, the Shin '698 publication does not teach or suggest any repeated presentation of the electronic document as now recited by amended independent Claim 35.

Independent Claim 36 includes a step of presenting at least a first locking requirement associated with the selected content to a user device with the locking requirement defining a specific period of time or a specified amount of usage for which the content is locked in the user device and is required to be presented. Independent Claim 36 also recites that the selected content and the first locking requirement are provided from a network based device to the user based device to permit the selected content to be repeatedly presented until the first selected locking requirement is met. As described above, the Shin '698 publication does not define a locking requirement in terms of either a specific period of time or a specific amount of usage for which the content is locked in and required to be presented at the user device. Instead, as described by the Shin '698 publication, the electronic document is actually prevented from being accessed by the user device so long as the locking condition is not met. Additionally, the Shin

'698 publication does not teach or suggest the repeated presentation of the selected content until the first selected locking requirement is met, as now recited by amended independent Claim 36. Instead, the Shin '698 publication does not discuss use of the electronic document once the locking condition is met other than indicating that the electronic document may then be accessed with no indication of its repeated presentation.

Similarly, independent Claim 39 includes the step of receiving the first locking requirement associated with selected content at a user device with the locking requirement defining a specific period of time or a specific amount of usage for which the content is locked in and required to be presented at the user device. After having accepted the first locking requirement, the selected content is received and stored and thereafter repeatedly presented with the user device until the first selected locking requirement is met. As described above, the Shin '698 publication does not define a locking requirement in terms of either a specific period of time or a specific amount of usage for which the content is locked in and required to be presented at the user device. Instead, as described by the Shin '698 publication, the electronic document is actually prevented from being accessed by the user device so long as the locking condition is not met. Additionally, the Shin '698 publication does not teach or suggest the repeated presentation of the selected content until the first selected locking requirement is met, as now also recited by amended independent Claim 39.

Independent Claim 42 is directed to a wireless mobile device that includes a content manager for receiving and managing selected content. In regards to the management of the selected content, the content manager of amended independent Claim 42 locks in the selected content pursuant to a first locking requirement such that the selected content is repeatedly presented until the first locking requirement is met. As described above, the Shin '698 publication does not teach or suggest the repeated presentation of the selected content until the first selected locking requirement is met, as now recited by amended independent Claim 42. Independent Claim 42 also defines the wireless mobile device to include a memory for storing a plurality of profiles. Each profile includes an identifier indicative of the use of the locked in, selected content. The Shin '698 publication does describe the structure of a locked document as shown in Figure 2B to have a number of fields including a field indicative of whether or not the

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document is locked, a field that defines the locking condition, a field that defines the message to be presented if the locking condition is not satisfied and a field that contains hierarchy information such as the author. However, none of the fields of the structure of the locked document nor any other portion of the Shin '698 publication teaches or suggest a memory containing profiles that each include an identifier indicative of the use of the locked in, selected content, as set forth by independent Claim 42. Instead, in the Shin '698 publication, once the locking condition is satisfied, a user is not limited in the use that can be made of the electronic document.

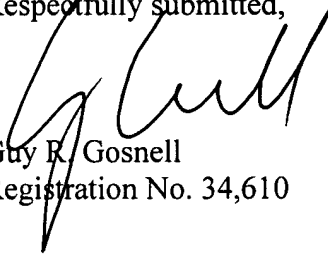
For each of the foregoing reasons, amended independent Claims 35, 36, 39 and 42, as well as the claims that depend therefrom, are not taught or suggested by the Shin '698 publication.

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Conclusion

In view of the foregoing amendments and the remarks presented above, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application. It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

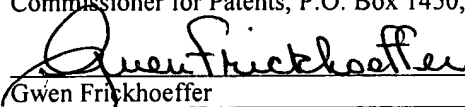
Respectfully submitted,


Guy R. Gosnell
Registration No. 34,610

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

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Gwen Frickhoeffer

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